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| 10/529,542 | 02/08/2006 | Christophe Chartier | 3888-0109PUS1 | 7891 |
| 2292 7590 12/15/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | | |
| EXAMINER | | | | |
| SHEWAREGED, BETTELHEIM | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1794 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 12/15/2008 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/529,542

Applicant(s)

CHARTIER ET AL.

Examiner

Betelhem Shewareged

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 3/29/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 6 is objected to because of the following informalities: A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation comprises a mixture of 20 to 100 parts by dry weight of magnesium fluorosilicate, of 0 to 80 parts by dry weight of calcium carbonate and of 0 to 10 parts by dry weight of amorphous silica, and the claim also recites 60 to 80 parts by dry weight of magnesium fluorosilicate, of 20 to 40 parts by dry weight of calcium carbonate and of 2 to 5 parts by dry weight of amorphous silica which is the narrower statement of the range/limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 and 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritt (EP 0 648 894 A1) in view of McCarthy et al. (US 5,989,696).

4. Claims 1, 2 and 12: Ritt teaches a paperboard and a coating layer provided on the paperboard, wherein the coating comprises a pigment having an oil absorbency of at least about 80g/100g pigment (abstract). The coated paperboard is for making cards {instant claim 12} (page 2, line 55). The coating further comprises dispersant and other conventional additives. Ritt does not teach magnesium fluorosilicate as the dispersant and/or other conventional additives. However, McCarthy teaches a coated web comprising a first coating containing synthetic hectorite which is commercially available under the tradename Laponite JS (col. 6, line 10) {instant claim 2}. Laponite JS is identical to the material used in the current invention. Ritt and McCarthy are analogous art because they are from similar problem solving area in relation to electrically conductive particles. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the electrically conductive particles of McCarthy with the invention of Ritt, and the motivation would be to control surface resistivity of the paperboard, and to minimize the change in surface resistivity

regardless the change in humidity, which results in improved handling and feeding of coated sheet (col. 7, lines 37-42).

5. Claims 3, 4 and 13: Ritt teaches the pigment is amorphous silica (page 2, line 57), and has high oil absorbency of at least about 80g/100g pigment (page 2, line 47).

6. Claims 7 and 8: The Office realizes that all of the claimed effects or physical properties are not positively stated by the reference(s). However, the reference(s) teaches all of the claimed ingredients. Therefore, the claimed effects and physical properties, i.e. optical density and surface resistivity would implicitly be achieved by a composite with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

7. Claims 9-11: Ritt teaches printing on the coated paperboard using ink (page 4, line 15). Since Ritt does not expressly disclose that the ink is conductive, it is interpreted that the ink is non-conductive. It is established that printed matter forms a certain form of pattern, but Ritt does not teach that the pattern is a barcode. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Whether the printed matter is a barcode or some other information the claimed print medium is not different from the coated paperboard of the combination of

Ritt and McCarthy because the coated paperboard of the combination of Ritt and McCarthy satisfies the claimed limitations. The printed information is capable of being read by a device sensitive to variations in electrical conductivity as recited in claim 11.

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritt (EP 0 648 894 A1) in view of McCarthy et al. (US 5,989,696) as applied to claim 1 above, and further in view of Shinozaki et al. (US 6,127,315).

9. The combination of Ritt and McCarthy teaches the claimed invention as set forth above. Ritt does not teach calcium carbonate as one of the dispersant and/or other conventional additives. However, Shinozaki teaches a print medium comprising a substrate and a coating layer comprising inorganic filler such as calcium carbonate (col. 4, lines 1-8 and col. 5, line 67). Ritt and Shinozaki are analogous art because they are from the same field of endeavor that is the printing medium art. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the calcium carbonate particles of Shinozaki with the invention of Ritt, and the motivation would be, as Shinozaki suggests, improving printing ink absorption, preventing printing ink running and enhancing ink fixing property (col. 4, lines 35-39).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 9am-5pm.
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS
December 6, 2008.

/Betelhem Shewareged/
Primary Examiner, Art Unit 1794